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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,926	03/12/2001	Salvatore Melis	Q63447	7232

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SUGHRUE, MION, ZINN
MACPEAK & SEAS, PLLC
2100 Pennsylvania Avenue, N.W.
Washington, DC 20037-3202

EXAMINER

BURCH, MELODY M

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/802,926

Applicant(s)

MELIS, SALVATORE

Examiner

Melody M. Burch

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,3,8,10,12 and 13 is/are rejected.
- 7) ☒ Claim(s) 4-7,9 and 11 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 2-13 are objected to because of the following informalities:
 - In line 3 of claim 4 and in line 1 of claim 5 the phrase "remote gearshift" should be changed to --remote manual gearshift-- to maintain consistent terminology;
 - In lines 3-4 of claim 9 the phrase "elongate element" should be changed to --elongate mechanical transmission element-- to maintain consistent terminology;
 - In lines 3 of claim 13 the phrase "gear rations" should be reworded for grammatical purposes. Appropriate correction is required.

The remaining claims are objected to due to their dependency from claim 13.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
3. Claim 10 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re: claim 10. The phrase "the electric motor" in line 1 is indefinite. It is unclear to the Examiner as to which of the electric motors Applicant intends to refer to since the phrase "actuator means...include, for each elongate element, an electric motor..." suggests the presence of a plurality of electric motors.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 3, 8, 12, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 1630076 to Schmidt in view of US Patent 6348023 to Martelli.

Re: claims 2, 12, and 13. Schmidt shows in figure 1 an operating unit for operation of a motor-vehicle gearbox 22 having a pair of mechanical operating members 25 for selection and engagement, respectively, the combined movement of which brings about the engagement of a selected gear ratios of the gearbox, the operating unit comprising, remote manual gearshift means 6 moveable into a plurality of positions for engagement of a desired gear ratio, actuator means 11,12,17 remote from the gearbox and operatively connected to the manual gearshift means for controlling the combined movement of the mechanical operating members in response to the position of the manual gearshift means, and flexible elongate mechanical transmission elements 19,27 connecting the actuator means to the mechanical operating members, whereby upon movement of the manual gearshift means to one of the positions results in the engagement of the corresponding gear ratio of the gearbox by the actuator means acting on the mechanical operating members through the flexible elongate mechanical transmission elements.

Schmidt fails to disclose a servo-assisted operation of the gearbox.

Martelli teaches in lines 4-6 of the abstract the use of a gearbox of a motor vehicle being operated in a servo-assisted manner in addition to the manual control (shifter 17, pedal 22).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the gearbox of Schmidt to have included operation in a servo-assisted manner in addition to the manual control (shifter and the shift linkage), as taught by Martelli, in order to provide a means of enabling the selection and engagement of the gears independently from the manual control which introduces a level of redundancy in the gearbox control system and improves system reliability.

Re: claim 3. Schmidt, as modified, teaches in figures 1 and 2 of Schmidt the limitation wherein the actuator means include shaft means 17 for controlling the movement of the elongate mechanical transmission elements.

Re: claim 8. Schmidt, as modified, teaches in figure 1 of Martelli and in lines 4-6 of the abstract of Martelli, the limitation wherein the actuator means 50,52, and 38,48 for controlling the movement of the transmission elements are electromechanical (particularly, in the servo-assisted operation mode).

Allowable Subject Matter

6. Claims 4-7, 9, and 11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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7. Claim 10 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

8. Applicant's arguments filed 6/29/04 have been fully considered but they are not persuasive. Schmidt describes the invention substantially as set forth above, but does not include the limitation of servo-assisted control. Martelli is used for the teaching of servo-assisted control of a gearbox. Applicant argues that there is no suggestion of modifying or replacing the conventional manual control of the gearbox with servo-assisted control. It is noted that with the modification of Schmidt in view of Martelli, the Examiner does not intend to replace the conventional manual control of the gearbox with servo-assisted control but to provide servo-assisted control in addition to manual control as taught by Martelli. Such a modification would meet the limitations of claim 13, which call for an operating unit for (or capable of) servo-assisted operation of a motor-vehicle gearbox. The claim language does not preclude the use of both manual and servo-assisted control means. Accordingly, the rejections have been maintained.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melody M. Burch whose telephone number is 703-306-4618. The examiner can normally be reached on Monday-Friday (7:30 AM-4:00 PM).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Lavinder can be reached on 703-308-3421. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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October 12, 2004

Melody M. Burch
10/12/04